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09/944,212	08/31/2001	Thomas M. Kurth	URE002 P309	2406
277 7590 02/18/2010 PRICE HENEVELD COOPER DEWITT & LITTON, LLP 695 KENMOOR, S.E. P O BOX 2567 GRAND RAPIDS, MI 49501				
EXAMINER COONEY, JOHN M				
ART UNIT		PAPER NUMBER		
1796				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

09/944,212

## Applicant(s)

KURTH ET AL.

## Examiner

John Cooney

## Art Unit

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 83-108 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 83-108 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 20091103
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Applicant's arguments filed 11-3-09 have been fully considered but they are not persuasive.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 83-108 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' recitation of (1.) ranges of amounts of blown vegetable oils used and (2.) ranges of amount values for the respective A- and B-side component parts as set forth in the claims are not supported by the originally filed supporting disclosure in a manner that it is evident that applicants' invention was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. This is a new matter invention.

Applicants' supporting disclosure lacks showing of support for possession of ranges of amount values for these respective claim components as now defined by the claims.

Applicants' arguments have been considered. However, rejection is maintained.

It is maintained that the recited value points for specific exemplified embodiments of applicants' invention are not supportive of the ranges of values now claimed. Further, even though applicants are now reciting ranges that are more represented by the examples, it is maintained that these examples are not supportive of the range of values for materials encompassed by the claims as they currently stand.

The fact scenarios in the cases cited by applicants' are different than those in the instant case. The issue in the instant case is one of whether the value points associated with the formulational make-up for specific compositions are supportive of the range of values now defined for the range of compositional formulations encompassed by the claims. It is not seen that these limited exemplary embodiments drawn to specific compositions from within the formulational limits of applicants' claims are supportive of the ranges of values now claimed for the compositions encompassed by the claims. While support for a narrower range of values may be evident when a broader range of values is disclosed, it is not seen that establishing a range of values from the exemplified embodiments provided in the instant case are supportive of the ranges of values now claimed {see also MPEP 2163.05[R-2] & 706.03(o)}.

Claims 83-108 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' recitation of ranges of heat values set forth in their claims (see claims 83, 93, 94, 96, 97 and 101) are not supported by the originally filed supporting disclosure in a manner that it is evident that applicants' invention was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. This is a new matter invention.

Applicants' supporting disclosure lacks showing of support for possession of ranges of heat values for these respective claim components as now defined by the claims.

Applicants' arguments have been considered. However, rejection is maintained. It is held and maintained that the recited value points for specific exemplified embodiments of applicants' invention are not supportive of the ranges of values now claimed. While support for a narrower range of values may be evident when a broader range of values is disclosed, it is not seen that establishing a range of values from the exemplified embodiments provided in the instant case are supportive of the ranges of values now claimed {see also MPEP 2163.05[R-2] & 706.03(o)}.

Claims 84 and 85 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. Applicants' recitation of ranges of amounts of the transesterified polyol are not supported by the originally filed supporting disclosure in a manner that it is evident that applicants' invention was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. This is a new matter invention.

Applicants' supporting disclosure lacks showing of support for possession of ranges of amount values for these respective claim components as now defined by the claims.

Applicants' arguments have been considered. However, rejection is maintained. The recited value points for specific exemplified embodiments of applicants' invention are not supportive of the ranges of values now claimed. Further, even though applicants are now reciting ranges that are represented by the examples at the claimed endpoints for specified compositions, it is maintained that these examples are not supportive of the range of values for materials encompassed by the claims as they currently stand. Hereto it is held and maintained that while support for a narrower range of values may be evident when a broader range of values is disclosed, it is not seen that establishing a range of values from the exemplified embodiments provided in the instant case are supportive of the ranges of values now claimed {see also MPEP 2163.05[R-2] & 706.03(o)}.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 83-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Croft (5,688,860) in view of Burke(4,185,146) and Trowell (4,720,571).

Croft discloses polymer materials comprising the reaction product of isocyanates, isocyanate reactive materials, catalysts, plasticizers, extenders/crosslinkers, and other materials of applicants' claims (see column 3 line 53 et seq. & column 10 line 60 – column 12 line 40, as well as, the entire document). Difference based on the ranges of A-side to B-side ratios {isocyanate Index values} is not seen.

Croft differs from applicants' claims in that it does not employ blown vegetable oils in its preparation. However, Burke (see column 1 lines 26-33, as well as, the entire document) discloses blown vegetable oils, including soya oil, to be well known materials used in urethane applications for purposes of providing acceptable reactant materials in forming urethane products. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the blown vegetable oils as isocyanate reactant materials in the preparations of Croft for the purpose of providing acceptable, natural, reactant materials in the reactive mixture in order to arrive at the products of

applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. As to the employed amounts of this respective component, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402. Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980). One looking employ a more environmentally friendly and less petroleum dependent reactive mix in balance with the other benefits of petroleum based polyols would towards variations in the amounts of respective components with the expectation of success in the absence of a showing of new or unexpected results that are attributable to differences in the claims and commensurate in scope with the scope of the claims. Further, selection of any known transesterification catalyst for purposes of providing transesterification would have been within the purview of the ordinary practitioner in the art in the absence of a showing of new or unexpected results that are demonstrated to be associated with the particular selection identified by the claim(s).

The teachings of Croft in view of Burke differ from applicants' claims in that they do not disclose employment of transesterification/esterification catalysts. However, Trowell (column 3 lines 54-57, as well as, the entire document) discloses the employment of transesterification/esterification catalysts to be well known to the polyurethane foam forming art for their effect of converting ester group containing materials to into isocyanate reactant materials. Accordingly, it would have been obvious



for one having ordinary skill in the art to have employed transesterification catalysts disclosed by Trowell in the preparations arriving from the combined teachings of Croft and Burke for the purpose of modifying the reactivities of the reactant materials and enabling enhanced properties in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Applicants' arguments and declaration on reply have been considered. However, rejection is maintained. Rejection over the combination of teachings is maintained to be evident.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is Burke that is looked to in order to address the deficiencies of Croft pertaining to the use of blown oils as isocyanate reactant materials, and Trowell (column 3 lines 54-57, as well as, the entire document) is looked to for the employment of transesterification/esterification catalysts in the polyurethane foam forming art for their effect of converting ester group containing materials to into isocyanate reactant materials. One looking to increase isocyanate reactive functionality for benefits including increased crosslink density of products ultimately formed would look to the teachings and fair suggestions of the combined prior art in order to arrive at the invention of applicants' claims.

The plasticizer of Croft is an additional additive/auxiliary component which is not excluded by the limitations of applicants' claims.

Applicants' declaration has been considered. However, the declaration is insufficient in negating the rejection above. However, setting forth experiments run and arguments made referring to the results of experiments run that are in apparent contradiction with what is taught by the examples of the cited disclosure are insufficient in negating the instant rejection under 35 USC 103. Further, applicants' tests do not include variations and adaptations from the reference disclosure which any competent worker in the art would be expected to make in order to make the reference disclosure operative. Additionally, applicants' narrow demonstration of the inoperability of a specific embodiment of the referenced Barthel, Jr.'s teaching from Burke does not negate what is disclosed by its fully considered disclosure. Accordingly, rejection is maintained to be proper as set forth above. Applicants' arguments as to the operability of the reference are unpersuasive, it is held and maintained that the disclosure of Barthel, Jr. is enabled in accordance with the requirements of MPEP 2121. Further, it should be noted that MPEP 2121 at its outset states that prior art is presumed to be operable/enabling, and applicants' have not presented evidence that sufficiently demonstrates inoperability of Barthel, Jr. in a way that meets the requirements of MPEP 716.07.

As to the added language of the claims pertaining to the make-up of the polyol and blown vegetable oils of the instant invention, it is seen that this descriptive language is directed towards features that are intrinsic to the make-up of these components, and

difference in a patentable sense based on this inserted language is not seen. Similarly, the language added in claim 84 is seen to be describing the transesterification reaction that has occurred in forming the products claimed, and difference over what is taught or fairly suggested by the teachings of the combinations of the prior art is not seen to be evident.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Cooney/  
Primary Examiner, Art Unit 1796